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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,548	12/13/2000	Uwe Schumann	BEIERSDORF 685-WCG	5636

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/736,548	Applicant(s) SCHUMANN ET AL.	
	Examiner Victor S Chang	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 5/18/2004. Applicants' amendments to claims 5 and 6, and newly added claims 12-17 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

Claim Rejections - 35 USC § 112

4. Claims 1, 4-9 and 11-17 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the structural relations among the backing material, the epoxy resin coating and the self-adhesive composition.

With respect to Applicants' comment "None of the rejections in paragraphs 3-5 on page 3 of the office action indicate anything more than a preference for alternative language rather than the claims being vague and indefinite." (Remarks, page 6, first complete paragraph), the Examiner notes while Applicants are entitled to the scope of originally filed claims, claims must be supported by the remainder of the specification. See MPEP § 2163.06. As such, since the structural relation between the epoxy resin

coating and the self-adhesive composition is absent from claim 1, the Examiner repeats (see Office action mailed 2/18/2004, page 3) that amendment to clarify the structure of the instantly claimed invention is requested, because it appears that a crosslinked epoxy coating at the outer surface is essential to obtain an improved high temperature resistance to endure the automotive paint baking temperature (specification, paragraphs 0011 and 0017). Put another way, the claim is unclear since one cannot determine from the language of the claim which side of the coated backing material receives the self-adhesive composition. Such information is imperative to define Applicants' rights of exclusivity and to make an accurate comparison with the prior art.

Response to Amendment

5. Claims 1, 4, 5 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinzer et al. (5667893) in view of Kolb (US 3391053), substantially for the reasons set forth in section 5 of Office action mailed 2/18/2004, together with the following additional observations.

Applicants' argument that "the most glaring difference between the appellants' invention and that of Kinzer is the lack of an explicit recitation for the use of an amine" has been carefully considered, but is not persuasive. The Examiner repeats (Office action mailed 2/18/2004, page 4, top paragraph) that Kinzer teaches that the use of epoxy resins in tape backings is known in the art (column 1, lines 40-41). Kinzer also teaches that the epoxy monomers of prior art backing must be processed by adding a curing agent (column 2, lines 9-13), and polyfunctional amines are known thermal

curing agents for epoxy resins (column 1, lines 23-25), Applicants' argument to the contrary notwithstanding.

With respect to Applicants' response arguing "it is difficult to see how one of ordinary skill in the art would arrive at the applicants' claims based on the teachings of Kinzer and Kolb", the Examiner repeats (see Office action mailed 2/18/2004, page 5, top paragraph) that since both Kinzer and Kolb are directed to a flexible electrical insulating adhesive tape, it would have been obvious to one of ordinary skill in the art to form the prior art tape backings by the teachings of Kinzer and Kolb, i.e., combining Kinzer's polyester film substrate and adhesives with Kolb's thermally cured epoxy/amine materials and modifiers, motivated by the desire to obtain a flexible electrical adhesive tape. It should be noted that the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. Additionally, the Examiner notes that while Applicants' invention appears to be directed to a different application, i.e., masking tape for automotive window flange during paint baking process, the preamble of claim 1 is "An adhesive tape". Further, even if the preamble is modified to include the use of the tape, it should be noted that mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. MPEP § 2145.II.

With respect to Applicants' argument "The characterization of hardeners as being equivalent to amines comes from the examiner not from the teachings of Kinzer. Furthermore, the recitation of hardeners is within a Markush-like groupings of optional adjuvants" (Remarks, page 11, third complete paragraph), the Examiner notes that

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Kinzer does teach that the epoxy monomers of prior art backing must be processed by adding a curing agent, and polyfunctional amines are known thermal curing agents for epoxy resins, as set forth above. As to the aforementioned "adjuvants", the Examiner would like to remind Applicants that the rejections over Kinzer's photopolymerizable epoxy composition has been withdrawn (see Office action mailed 2/18/2004, page 2, bottom paragraph), Applicants' argument appears to be misplaced.

Similarly, Applicants' arguments in sections (b)–(d), such as "Kinzer only describes the related art as teaching the use of crosslinked structures. However, there is no evidence that Kinzer's product itself is crosslinked." (Remarks, page 12, section (b)), all appear to be misplaced, since the rejections over Kinzer's photopolymerizable epoxy composition has already been withdrawn, as set forth above.

For newly added claim 13, the Examiner notes that Applicant fails to appreciate that, in an article claim, statements of contemplated use and functional language of a process of use are patentably irrelevant. Since the prior art combination renders both the structure and composition of the instantly claimed invention obvious, it is the Examiner's position that mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. MPEP § 2145.II.

For newly added claims 14 and 15, the Examiner notes that neither the prior art taught by Kinzer, nor Kolb's epoxy coating requires polyvinylchloride.

6. Claims 6, 7, 11, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinzer et al. (5667893) in view of Wiest et al. (US 4322516)

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substantially for the reasons set forth in section 6 of Office action mailed 2/18/2004, together with the following additional observations.

For newly added claims 16 and 17, the Examiner repeats that statements of contemplated use and functional language of a process of use are patentably irrelevant; further, neither the prior art taught by Kinzer, nor Kolb's epoxy coating requires polyvinylchloride, as set forth above. Additionally, since the prior art combination renders both the structure and composition of the instantly claimed invention obvious, the Examiner repeats that mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention, as set forth above. MPEP § 2145.II.

7. Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kneisel (US 5741383), substantially for the reasons set forth in section 7 of Office action mailed 2/18/2004, together with the following additional observations.

For claim 8, with respect to Applicants' argument "When considering the Kneisel references as a whole, there is no indication that the reference teaches or suggests using the adhesive tape described by applicant's claim 1." (Remarks, page 17, forth full paragraph), the Examiner repeats (see Office action mailed 2/18/2004, page 6, bottom paragraph) that it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961).

For newly added claim 12, Kneisel expressly teaches that if the vehicle is to be coated with a rust-resistant coating composition (such as by electrodeposition means),

the masking composition is preferably applied after the application and drying of such coating (column 4, lines 7-11). As such, Kneisel's teaching clearly reads on the instantly claimed cathodic electrocoat.

8. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinzer et al. (5667893), substantially for the reasons set forth in section 8 of Office action mailed 2/18/2004, together with the following additional observations.

For claims 9 and 10, with respect to Applicants' argument "Inherency ... may not be established by probabilities or possibilities" (Remarks, page 15, last full paragraph), the Examiner apologizes for an inadvertent typo, as the phrase "inherently disclosed" should be corrected as "implicitly disclosed", as such the phrase "inherently disclosed" is withdrawn. However, since the alternative analysis, set forth in the previous Office action (mailed 2/18/2004, page 7) indicating that "applying a mixture of starting components of the epoxy resin during their chemical reaction phase onto the polyester film substrate is ... or an obvious nominal coating step to one of ordinary skill in the art of epoxy coating", is still deemed to be proper, it is believed that the aforementioned error has caused no harm to the Applicants.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VSC
Victor S Chang
Examiner
Art Unit 1771

7/7/2004


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